

REMARKS

By this Preliminary Amendment, Claims 1-26 have been cancelled. Claims 27-29 have been added. Support for claims 27-29 is detailed below. Upon entry of this Amendment, claims 27-29 are pending. Claim 27 substantially corresponds to claim 4 of U.S. Patent Application Serial No. 10/457,310 ("the '310 application"), filed June 9, 2003, and claim 4 of U.S. Patent Application Serial No. 10/719,769 ("the '769 application"), filed November 21, 2003, and has been added for the purpose of provoking an interference with the '310 and '769 applications.

The undersigned requests a Declaration of Interference with the '310 and '769 applications.

Requirements of 37 C.F.R. §41.202

Applicants submit the following information as required by 37 C.F.R. §41.202.

1. Identification of Patent Application – 37 C.F.R. §41.202(a)(1)

In accordance with 37 C.F.R. §41.202(a)(1), Applicants request that an interference be declared between U.S. Patent Application Serial No. 10/727,561 ("the present application") and the '310 and '769 applications.

U.S. Patent Application Serial No. 10/457,310

Filed: June 9, 2003

Title: Methods and Apparatus for Laminating Documents

Inventor: Kenneth Ian Greenhill

Art Unit: 1734

Examiner: Linda Gray

U.S. Patent Application Serial No. 10/719,769

Filed: November 21, 2003

Title: Methods and Apparatus for Laminating Documents

Inventor: Kenneth Ian Greenhill

Art Unit: 1772

Examiner: Nasser Ahmad

2. Proposed Count and Corresponding Claims – 37 C.F.R. §41.202(a)(2)

In accordance with 37 C.F.R. §41.202(a)(2), and *Orikasa v. Oonishi*, 10 USPQ2d 1996 (Comr. Pats. 1989), Applicants present the following proposed count:

Count

A lamination product comprising:
a substrate having pressure sensitive adhesive material on one side;
release material covering a first portion of the one side and exposing a second portion of the one side, and

a transparent laminate secured to the substrate at the second portion of the one side, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,

whereby a document can be secured in the lamination product by lifting the unadhered portion of the laminate, placing the document between the laminate and the substrate, removing the release material to expose the pressure sensitive adhesive material on the first portion of the substrate, and pressing the document and laminate against the exposed adhesive of the first portion, and

wherein the release liner is folded to expose the second portion.

OR

A method for laminating a document in a lamination product having
a substrate having pressure sensitive adhesive material on one side,
release material covering a first portion of the one side and exposing a second portion of the one side, and

a transparent laminate secured to the substrate at the second portion of the one side, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material, wherein the release material is folded to expose the second portion, the method comprising:

placing the document between the laminate and the substrate;
removing the release material to expose the pressure sensitive adhesive material on the first portion of the substrate; and
pressing the document and laminate against the exposed adhesive of the first portion.

OR

A method for manufacturing a lamination product comprising the steps of
moving a web of material along a path, the web having pressure sensitive adhesive on
one side, the pressure sensitive adhesive being covered by release material,
exposing the pressure sensitive adhesive along an edge of the web,
adhering transparent laminate to the web where the pressure sensitive adhesive is
exposed, the laminate also covering the release material, and
die cutting the web into individual lamination products having a desired size.

The Count is provided in the alternative because it is believed that the product, the
method for using the product, and the method for making the product are directed to the same
patentable invention. *See Orikasa v. Oonishi*, 10 USPQ2d 1996, 2003 (Comr. Pats. 1989). In
the *Orikasa* case, the Commissioner of Patents directed that where method and product
claims are the "same patentable invention" for purposes of an interference, the Count should
be drafted in the alternative. Here, the Applicants submit that the product and method claims
set forth in the Count are not separately patentable, and thus have crafted the Count in
alternative form.

Applicants identify the following claims as corresponding to the Count proposed
above:

Claims 1, 2, 4, 5, 7, and 8 of the '310 application¹;
Claims 1, 2, 4, 9, 11, and 15 of the '769 application²; and
Claims 27-29 of the present application.

3. Claim Chart – 37 C.F.R. §41.202(a)(3)

In accordance with 37 C.F.R. § 41.202(a)(3), Applicants provide the following
claim chart comparing at least one claim of the '310 application, at least one claim of the
'769 application, and at least one claim of the present application to the proposed Count.

¹ The Applicants submit that claims 1, 2, and 8 of the '310 application are clearly unpatentable over U.S. Patent No. 3,827,726 ("the '726 patent"). Thus, the Applicants designation of these claims is merely for preliminary purposes, as they correspond to the Count because they are anticipated by the Count. Moreover, the Examiner should reject these claims as not being novel or not being unobvious over the '726 patent, and thus they should not be included in any interference.

² The Applicants submit that claims 1, 2, and 15 of the '769 application are clearly unpatentable over the '726 patent. Thus, the Applicants designation of these claims is merely for preliminary purposes, as they correspond to the Count because they are anticipated by the Count. Moreover, the Examiner should reject these claims as not being novel or not being unobvious over the '726 patent, and thus they should not be included in any interference.

Proposed Count (first portion only)	Exemplary Claim from the '310 Application: Claim 4, which depends from Claim 1	Exemplary Claim from the '759 Application: Claim 4, which depends from Claim 1	Exemplary Claim from the Present Application: Claim 27
<p>A lamination product comprising:</p> <p>a substrate having pressure sensitive adhesive material on one side;</p> <p>release material covering a first portion of the one side and exposing a second portion of the one side, and</p> <p>a transparent laminate secured to the substrate at the second portion of the one side, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,</p> <p>whereby a document can be secured in the lamination product by lifting the unadhered portion of the laminate, placing the document between the laminate and the substrate, removing the release material to expose the pressure sensitive adhesive material on the first portion of the substrate,</p>	<p>1. A lamination product comprising</p> <p>a substrate having pressure sensitive material on one side,</p> <p>release material covering a first portion of the one side and exposing a second portion of the one side, and</p> <p>a transparent laminate secured to the substrate by the exposed pressure sensitive adhesive, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,</p> <p>whereby a photograph or other document can be secured in the lamination product by lifting the unadhered portion of the laminate, placing the photograph between the laminate and the substrate, removing the release layer to expose the pressure sensitive adhesive layer on the first portion of the</p>	<p>1. A lamination product comprising</p> <p>a substrate having pressure sensitive material on one side,</p> <p>release material covering a first portion of the one side and exposing a second portion of the one side, and</p> <p>a transparent laminate secured to the substrate by the exposed pressure sensitive adhesive, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,</p> <p>whereby a photograph or other document can be secured in the lamination product by lifting the unadhered portion of the laminate, placing the photograph between the laminate and the substrate, removing the release layer to expose the pressure sensitive adhesive layer on the first portion of the</p>	<p>27. A lamination product comprising:</p> <p>a substrate having pressure sensitive adhesive material on one side;</p> <p>release material covering a first portion of the one side and exposing a second portion of the one side, and</p> <p>a transparent laminate secured to the substrate at the second portion of the one side, a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,</p> <p>whereby a document can be secured in the lamination product by lifting the unadhered portion of the laminate, placing the document between the laminate and the substrate, removing the release material to expose the pressure sensitive adhesive material on the first portion of the substrate,</p>

and pressing the document and laminate against the exposed adhesive of the first portion, and	substrate, and pressing the photograph and laminate against the exposed adhesive of the first portion.	substrate, and pressing the photograph and laminate against the exposed adhesive of the first portion.	and pressing the document and laminate against the exposed adhesive of the first portion, and
wherein the release material is folded to expose the second portion.	4. The product of claim 1 wherein the release material is folded to expose the second portion.	4. The product of claim 1 wherein the release material is folded to expose the second portion.	wherein the release material is folded to expose the second portion.

Claim 4 of the ‘310 application, claim 4 of the ‘769 application, and claim 27 of the present application interfere within the meaning of 37 C.F.R. §41.203(a), because claim 27 of the present application would, if prior art, anticipate (or render obvious) the subject matter of claim 4 of the ‘310 application and claim 4 of the ‘769 application, and vice versa.

4. Priority – 37 C.F.R. §41.202(a)(4)

In accordance with 37 C.F.R. § 41.202(a)(4), Applicants will prevail on priority for *at least* the reason that Applicants have the earliest constructive reduction to practice. The present application claims priority from U.S. Provisional Patent Application No. 60/433,606, filed December 16, 2002, entitled “DEVICE AND METHOD FOR PERFORMING A MASTER PROCESSING OPERATION,” and all the pending claims are adequately supported in that provisional application (see section 6 below). As such, the present application has a constructive reduction to practice date of December 16, 2002.

The ‘310 application, by contrast, was filed on June 9, 2003, almost 6 months after the provisional filing date for the present application. Also, the ‘310 application claims priority from U.S. Provisional Patent Application No. 60/465,405, filed on April 24, 2003, entitled “SELF-CONTAINED PHOTO LAMINATION DEVICE.” Even assuming for the sake of argument that the claimed invention of the ‘310 application is fully supported by Application No. 60/465,405, the ‘310 application would have a constructive reduction to practice date of April 24, 2003, which is still over 4 months later than that of the present application.

The ‘769 application, which is a continuation-in-part of the ‘310 application, was filed on November 21, 2003, almost 12 months after the provisional filing date for the present

application. As noted above, the '310 application claims priority from U.S. Provisional Patent Application No. 60/465,405, filed on April 24, 2003, entitled "SELF-CONTAINED PHOTO LAMINATION DEVICE." Even assuming for the sake of argument that the claimed invention of the '769 application is fully supported by Application No. 60/465,405, the '769 application would have a constructive reduction to practice date of April 24, 2003, which is over 4 months later than that of the present application.

5. Claim Chart – 37 C.F.R. §41.202(a)(5)

In accordance with 37 C.F.R. §41.202(a)(5), Applicants submit the following claim chart showing written description for each claim in Applicants' Specification. The citations are exemplary only, and are not exclusive or exhaustive. Indeed, additional and/or alternative support can also be found in other portions of the specification.

Pending Claims	Exemplary Citations to Support in the Specification of the Present Application
27. A lamination product comprising:	The specification discloses a lamination product in the form of a device for performing a laminating operation on a selected substrate (e.g., document) (p. 3 [0014]).
a substrate having pressure sensitive adhesive material on one side;	The specification discloses an adhesive carrier substrate 16 that has a layer of pressure-sensitive adhesive on one side (e.g., the inner surface 18) (p. 3, [0015]).
release material covering a first portion of the one side and exposing a second portion of the one side, and	The specification discloses a release material in the form of a release liner 22 that separates the base substrate 14 from the adhesive substrate 16 (p. 4, [0018]). As shown in Figure 2, the release liner 22 covers part of the one side of the adhesive carrier substrate 16. The part that is covered by the release liner 22 corresponds to the "first portion" and the part that is not covered by the release liner 22 corresponds to the "second portion," which is "exposed" vis-à-vis the release liner in the sense that it is not covered by the release liner 22. (Figure 2).
a transparent laminate secured to the substrate at the second portion of the one side,	The specification discloses a transparent laminate in the form of a base substrate 14. The specification also discloses that if separate sheets are used for the base substrate 14 and the adhesive substrate 16, it is preferable to bond them together (p. 4, [0016]). Figure 2 shows the sheets secured to

	each other in the area where the release material is not present (i.e., the second portion) (Figure 2).
a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,	The specification discloses that release liner 22 separates the base substrate 14 from the adhesive carrier substrate 16 (p. 4, [0018]), hence it overlies the first portion of the adhesive carrier substrate 16. (Figure 2).
whereby a document can be secured in the lamination product by lifting the unadhered portion of the laminate,	The specification discloses that a document (i.e., selected substrate 12) may be laminated by separating (i.e. lifting) the base substrate 14 from the release liner 22 and the adhesive substrate 16 (p. 5, [0020]).
placing the document between the laminate and the substrate,	The specification discloses that the document may be positioned in a master processing position between the release liner 22 and the base substrate 14 (p. 5, [0020]), and hence, the substrate 16.
removing the release material to expose the pressure sensitive adhesive material on the first portion of the substrate, and	The specification discloses that the release liner 22 is removed (withdrawn) from between the adhesive substrate 16 and the base substrate 14 and the document 12 so that the pressure-sensitive adhesive can adhere to the document (p. 6, [0021]).
pressing the document and laminate against the exposed adhesive of the first portion, and	The specification discloses that the action of pulling the release liner 22 into engagement against the document 12 and laminate 14 affects adhesive bonding between the base substrate 14, the document 12, and the adhesive carrier substrate 16. As a result, these are pressed together to create the bond. (p. 6, [0021]).
wherein the release material is folded to expose the second portion.	The specification discloses that the release liner 22 is folded along a fold line 23. (p. 4, [0018]). Figure 2 shows that the release liner 22 is folded, thereby exposing the "second portion" of the adhesive substrate 16, as discussed above. (Figure 2).
28. The product of claim 27, wherein the document is smaller than the first portion of the substrate, so that the laminate is secured to the substrate around all outer edges of the document.	The specification discloses that the pressure-sensitive adhesive is enabled to adhere to the document 12 and any peripheral portions of the base substrate extending adjacent the periphery of the document 12 (p. 6 [0021]).
30. A method for laminating a document in a lamination product having	The specification discloses a device for performing a laminating operation on a document (p. 3 [0014]).
a substrate having pressure sensitive adhesive material on one side,	The specification discloses an adhesive carrier substrate 16 that has a layer of

	pressure-sensitive adhesive on one side (e.g., the inner surface 18) (p. 3, [0015]).
release material covering a first portion of the one side and exposing a second portion of the one side, and	The specification discloses a release material in the form of a release liner 22 that separates the base substrate 14 from the adhesive substrate 16 (p. 4, [0018]). As shown in Figure 2, the release liner 22 covers part of the one side of the adhesive carrier substrate 16. The part that is covered by the release liner 22 corresponds to the "first portion" and the part that is not covered by the release liner 22 corresponds to the "second portion," which is "exposed" vis-à-vis the release liner in the sense that it is not covered by the release liner 22. (Figure 2).
a transparent laminate bonded to the substrate at the second portion of the one side,	The specification discloses a transparent laminate in the form of a base substrate 14. The specification also discloses that if separate sheets are used for the base substrate 14 and the adhesive substrate 16, it is preferable to bond them together (p. 4, [0016]). Figure 2 shows the sheets secured to each other in the area where the release material is not present (i.e., the second portion) (Figure 2).
a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,	The specification discloses that release liner 22 separates the base substrate 14 from the adhesive carrier substrate 16 (p. 4, [0018]), hence it overlies the first portion of the adhesive carrier substrate 16. (Figure 2).
wherein the release material is folded to expose the second portion,	The specification discloses that the release liner 22 is folded along a fold line 23. (p. 4, [0018]). Figure 2 shows that the release liner 22 is folded, thereby exposing the "second portion" of the adhesive substrate 16, as discussed above. (Figure 2).
the method comprising: placing the document between the laminate and the substrate;	The specification discloses that the document may be positioned in a master processing position between the release liner 22 and the base substrate 14 (p. 5, [0020]), and hence, the substrate 16.
removing the release material to expose the pressure sensitive adhesive layer on the first portion of the substrate; and	The specification discloses that the release liner 22 is removed (withdrawn) from between the adhesive substrate 16 and the base substrate 14 and the document 12 so that the pressure-sensitive adhesive can adhere to the document (p. 6, [0021]).
pressing the document and laminate against the exposed adhesive of the first portion.	The specification discloses that the action of pulling the release liner 22 into engagement against the document 12 and laminate 14

	affects adhesive bonding between the base substrate 14, the document 12, and the adhesive carrier substrate 16. As a result, these are pressed together to create the bond. (p. 6, [0021]).
--	---

6. Constructive Reduction to Practice – 37 C.F.R. §41.202(a)(6)

In accordance with 37 C.F.R. §41.202(a)(6), Applicants wish to be accorded the benefit of a constructive reduction to practice date of December 16, 2002 for at least the reason that the present application claims priority from U.S. Provisional Patent Application Serial No. 60/433,606, filed December 16, 2002. Applicants further note that although the present specification contains information that was not in the specification of the Provisional Patent Application Serial No. 60/433,606, filed December 16, 2002, all of the features of the claims contained in this Preliminary Amendment were disclosed in the Provisional Patent Application. The claim chart set forth below illustrates how the disclosure provides a constructive reduction to practice within the scope of the interfering subject matter as of December 16, 2002.

Pending Claims	Exemplary Citations to Support in the Specification of 60/433,606
27. A lamination product comprising:	The specification discloses a lamination product in the form of a device for performing a laminating operation on a selected substrate (e.g., document) (p. 3 [0007]).
a substrate having pressure sensitive adhesive material on one side;	The specification discloses an adhesive carrier substrate 16 that has a layer of pressure-sensitive adhesive on one side (e.g., the inner surface 18) (p. 3, [0008]).
release material covering a first portion of the one side and exposing a second portion of the one side, and	The specification discloses a release material in the form of a release liner 22 that separates the base substrate 14 from the adhesive substrate 16 (p. 4, [0011]). As shown in Figure 2, the release liner 22 covers part of the one side of the adhesive carrier substrate 16. The part that is covered by the release liner 22 corresponds to the “first portion” and the part that is not covered by the release liner 22 corresponds to the “second portion,” which is “exposed” vis-à-vis the release liner in the sense that it is not covered by the release liner 22. (Figure 2).

a transparent laminate secured to the substrate at the second portion of the one side,	The specification discloses a transparent laminate in the form of a base substrate 14. In one embodiment, the base substrate 14 and adhesive carrier substrate 16 are part of a single sheet. (p. 3, [0009], Figure 1.) The specification also discloses that separate sheets may be used for the base substrate 14 and the adhesive carrier substrate 16 (p. 3, [0009]), which would obviously be secured to one another at the portion of the adhesive carrier substrate that is not covered by the release liner 22.
a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,	The specification discloses that release liner 22 separates the base substrate 14 from the adhesive carrier substrate 16 (p. 4, [0011]), hence it overlies the first portion of the adhesive carrier substrate 16. (Figure 2).
whereby a document can be secured in the lamination product by lifting the unbonded portion of the laminate,	The specification discloses that a document (i.e., selected substrate 12) may be laminated by separating (i.e. lifting) the base substrate 14 from the release liner 22 and the adhesive substrate 16 (p. 4, [0013]).
placing the document between the laminate and the substrate,	The specification discloses that the document may be positioned in a master processing position between the release liner 22 and the base substrate 14 (p. 4, [0013]), and hence, the substrate 16.
removing the release material to expose the pressure sensitive adhesive material on the first portion of the substrate, and	The specification discloses that the release liner 24 is removed (withdrawn) from between the adhesive substrate 16 and the base 14 and the document 12 so that the pressure-sensitive adhesive can adhere to the document (p. 5, [0014]).
pressing the document and laminate against the exposed adhesive of the first portion, and	The specification discloses that the action of pulling the release liner 24 into engagement presses it against the document 12 and laminate 14. (p. 5, [0014]).
wherein the release material is folded to expose the second portion.	The specification discloses that the release liner 22 is folded along a fold line 23. (p. 4, [0011]). Figure 2 shows that the release liner 22 is folded, thereby exposing the "second portion" of the adhesive substrate 16, as discussed above. (Figure 2).
28. The product of claim 27, wherein the document is smaller than the first portion of the substrate, so that the laminate is secured to the substrate around all outer edges of the document.	The specification discloses that the pressure-sensitive adhesive is enabled to adhere to the document 12 and any peripheral portions of the base substrate extending adjacent the periphery of the document 12 (p. 5 [0014]).

29. A method for laminating a document in a lamination product having	The specification discloses a device for performing a laminating operation on a document (p. 3 [0007]).
a substrate having pressure sensitive adhesive material on one side,	The specification discloses an adhesive carrier substrate 16 that has a layer of pressure-sensitive adhesive on one side (e.g., the inner surface 18) (p. 3, [0008]).
release material covering a first portion of the one side and exposing a second portion of the one side, and	The specification discloses a release material in the form of a release liner 22 that separates the base substrate 14 from the adhesive substrate 16 (p. 4, [0011]). As shown in Figure 2, the release liner 22 covers part of the one side of the adhesive carrier substrate 16. The part that is covered by the release liner 22 corresponds to the "first portion" and the part that is not covered by the release liner 22 corresponds to the "second portion," which is "exposed" vis-à-vis the release liner in the sense that it is not covered by the release liner 22. (Figure 2).
a transparent laminate secured to the substrate at the second portion of the one side,	The specification discloses a transparent laminate in the form of a base substrate 14. In one embodiment, the base substrate 14 and adhesive carrier substrate 16 are part of a single sheet. (p. 3, [0009], Figure 1.) The specification also discloses that separate sheets may be used for the base substrate 14 and the adhesive carrier substrate 16 (p. 3, [0009]), which would obviously be secured to one another at the portion of the adhesive carrier substrate that is not covered by the release liner 22.
a portion of the laminate covering the first portion of the substrate and not being adhered to the substrate due to the release material,	The specification discloses that release liner 22 separates the base substrate 14 from the adhesive carrier substrate 16 (p. 4, [0011]), hence it overlies the first portion of the adhesive carrier substrate 16. (Figure 2).
wherein the release material is folded to expose the second portion,	The specification discloses that the release liner 22 is folded along a fold line 23. (p. 4, [0011]). Figure 2 shows that the release liner 22 is folded, thereby exposing the "second portion" of the adhesive substrate 16, as discussed above. (Figure 2).
the method comprising: placing the document between the laminate and the substrate;	The specification discloses that the document may be positioned in a master processing position between the release liner 22 and the base substrate 14 (p. 4, [0013]), and hence, the substrate 16.

removing the release material to expose the pressure sensitive adhesive layer on the first portion of the substrate; and	The specification discloses that the release liner 24 is removed (withdrawn) from between the adhesive substrate 16 and the base 14 and the document 12 so that the pressure-sensitive adhesive can adhere to the document (p. 5, [0014]).
pressing the document and laminate against the exposed adhesive of the first portion.	The specification discloses that the action of pulling the release liner 24 into engagement presses it against the document 12 and laminate 14. (p. 5, [0014]).

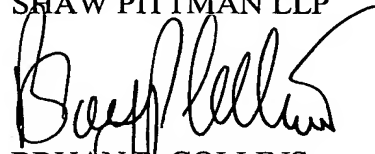
Conclusion

For the above reasons, Applicants respectfully request an interference be declared between the present application and the '310 and '769 applications. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP
SHAW PITTMAN LLP



BRYAN P. COLLINS
Reg. No. 43,560
Tel. No. 703.905.2038

EMILY T. BELL
Reg. No. 47,418
Tel. No. 703.905.2261

Date: May 3, 2005
P.O. Box 10500
McLean, VA 22102
Tel. No. 703.905.2000
Fax No. 703.905.2500